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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,883	01/10/2000	SCOTT T. ALLAN	A-65188-1/TO	4877

7590

04/07/2003

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EXAMINER

JASMIN, LYNDIA C

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/480,883

Applicant(s)

ALLAN ET AL. 

Examiner

Lynda C Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,9-11,13,14,21-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,9-11,13,14,21-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Amendment received on January 23, 2003 has been acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3, 4, 9-11, 23, 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tognazzini (5,739,512).

Tognazzini discloses a method for storing and retrieving electronic records as claimed with the step of: creating a transaction at a merchant location by buying one of goods and service (purchase transactions via 220), authorizing the transaction with an electronic signature (col. 2, lines 46-48), forwarding an electronic record of the transaction, including the electronic signature and a text description of a line item relating to the transaction (col. 6, lines 14-16), to an electronic-record repository (col. 2,

lines 31-40 and lines 44-48), and forwarding to the electronic-record repository an electronic record of a transaction created at a business other than the merchant (via the credit card company issuing the electronic receipt).

In another embodiment, Tognazzini discloses creating the transaction by buying from a virtual merchant (col. 3, lines 28-38).

Tognazzini further discloses generating a paper receipt for the transaction (col. 5, lines 23 and 24), and retrieving a replica of the paper transaction receipt from the electronic-record repository over the Internet (co. 6, lines 37-39 and lines 62-65).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13, 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini in view of Kobayashi et al. (5,864,825).

Tognazzini further discloses the step of emailing receipt from company database to the customer (see step 850), with the exception of offering a search of an electronic-record repository by text line-item description and downloading, faxing and printing a copy of the electronic record from the electronic-record repository.

Kobayashi et al. discloses the process steps of offering a search of an electronic-record repository by text line-item description (data of goods such as name of articles)

(col. 4, lines 63-67), and retrieving requesting receipt from a host unit and transferred the data result to a printer, which prints the results (at S17), or downloading to the customer IC card.

From this teaching of Kobayashi et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retrieving process of Robinson et al to include the searching and printing of the receipt from a storage as taught by Kobayashi et al. in order to provide a transcript of a purchase receipt when the receipt is missing. Faxing a copy of the receipt from the electronic-report repository is a well-known medium of sending and receiving communication. Thus, it would have been obvious to one of ordinary skill in the art the time the invention was made to have provided the step of faxing a copy to the customer in Kobayashi et al. in order to facilitate transmission of record.

6. Claims 22-26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini.

Tognazzini further discloses the step retrieving the electronic record as proof of transaction in case of disputes or problems with the order (for e.g. audit or historical purposes from a database) however, fails to explicitly discloses using the electronic record as proof of the transaction in order to return/exchange the bought goods or service, or to file a warranty claim with respect to the bought goods or service. However, this practice is well known in the business community and would follow in the Internet world as well where customer is worldwide. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have

added the well known steps of providing the electronic record as proof of transaction in order to return/exchange and to file a warranty claim of the bought goods or service in the process of Tognazzini for the purpose of streamlining the process and saving time spent by customer searching for paper transaction.

As per claim 29, forwarding the electronic record in a batch-compatible fashion is well known in financial institution (e.g. bank card company) to process and store transaction at the end of business day. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the credit card company of Tognazzini with a batch-compatible fashion in order to facilitate faster service during business hours.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 3, 4, 9-11, 13, 14, 21-27 and 29-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within


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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

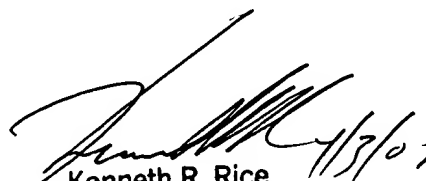
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda C Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.


Lynda C Jasmin
Examiner
Art Unit 3627

lj
April 3, 2003


Kenneth R. Rice
Primary Examiner